

No. 15,630

IN THE

United States Court of Appeals

FOR THE NINTH CIRCUIT

AMERICAN PIPE AND CONSTRUCTION Co.,

Appellant,

vs.

SPENCER A. EARNSHAW,

Appellee.

BRIEF ON BEHALF OF APPELLEE,
SPENCER A. EARNSHAW.

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Statement of Pleadings and Jurisdiction.

The Appellee, Earnshaw, adopts as his statement of the pleadings and facts disclosing the basis upon which it is contended that the District Court had jurisdiction and that the Appellate Court has jurisdiction to review the judgment, decree or order in question, the matter appearing in the Appellant's brief, pages 1, 2 and 3, under the title "Statement of the Pleadings and Jurisdiction," and Appellee also adopts the statement on page 3 of Appellant's brief under the title "The Parties."

Under the title "Concise Statement of the Case," the Appellee does not adopt the "Concise Statement of the Case" as set forth in the Appellant's brief *in toto*, particularly as to numerous conclusions set forth as to the effect of evidence and therefore Appellee gives the following background to the case.

This case originally arose as stated by the Appellant, in the Superior Court in and for the County of Los Angeles, State of California, by way of Complaint [R. 6] for certain royalties alleged by Appellee to be due from the Appellant under a patent License Agreement, Exhibit A to the Complaint [R. 11]. Subsequently, the case was removed to the Federal Court for the reasons which have been set forth in the Statement of the Pleadings and Jurisdiction, the Appellant having pleaded the existence of a controversy involving patents. The particular contract [Ex. A; R. 11], provides in Paragraph (11), the following:

“If either American or Earnshaw invents any improvements to the processes and methods of Patent No. 2168329 which, in the judgment of American are applicable to the manufacture, or lining, or coating of pipe, the said improvements shall inure to the benefit of both parties on the terms herein set forth and American will pay the costs of patenting the same.”

and Paragraph 12 of said License Agreement reads, as follows:

“(12) It is understood by both parties hereto that American is now using a brush coating machine for the coating of pipe and a centrifugal process for lining pipe, and it is further understood that American is at liberty to continue to use the said processes and/or the processes and methods of Patent No. 2168329 at its option. Improvements or patents applicable to the said brush coating machine and/or centrifugal lining process are expressly excluded from the provisions of Paragraph 11 hereof. The improvements and additional patents referred to in Paragraph 11 shall include only such improvements and patents as refer to and are applicable to Patent No. 2168329, a belt lining machine.” [R. 14-15.]

The Appellee, Earnshaw, has testified [R. 93, 94, 96] that he gave due notice of patents thereafter issued to him, to-wit, Plaintiff's Exhibit 5, Patent No. 2,639,943 [Exhibit Book, p. 257]; Exhibit 6, Patent No. 2,639,942 [Exhibit Book, p. 267], and Exhibit 7, Patent No. 2,681,725 [Exhibit Book, p. 273] by reason of Paragraph (11) of the contract, Exhibit A [R. 14]. There is evidence to the effect that the Appellant was using at its plant what is known as a Brend machine under license from Lock Joint Pipe Company [R. 102, 107] of a type substantially as disclosed in the Brend Patent No. 2,380,499, Defendant's Exhibit B [Exhibit Book, p. 279]. The Brend patent aforesaid discloses a wire brush construction for applying a plastic coating and consists of two drums both provided with wire bristles which counter-rotated for directing a stream of material onto a pipe which is to be coated. Appellee learned that the Appellant was utilizing what is termed the rubber rollers in place of wire brushes on the Brend machine [R. 93] which came within the teaching of Appellee's Patent No. 2,639,943 [Book of Exhibits, No. 5, p. 257] and hence the Appellee by his Complaint, filed after the expiration of Appellee's Patent No. 2,168,329 [Pltf. Ex. 2; Book of Exhibits, p. 245], demanded royalties from the Appellant as see Complaint, Paragraph VII [R. 8 and 9]. The Court below, however, in its decision [R. 57 at R. 59] stated, in part:

“* * * the uncontradicted fact remains that the license agreement between the parties specifically excluded improvements on the device which they were then using and which conformed to the teachings of the Brend patent.”

and see Finding of Fact 13 [R. 64], to-wit:

“That the substitution of rubber brushes for bristle brushes in the ‘Brend’ machine, if it constituted an improvement, was an improvement to the ‘Brend’ machine and not to the machine of Plaintiff’s patent No. 2,168,329.”

and likewise see Conclusion of Law 3 [R. 64], which reads as follows:

“That the ‘improvements’ referred to in paragraph (11) of the agreement of February 8, 1944 are limited to ‘improvements’ on the machine disclosed in Plaintiff’s Letters Patent No. 2,168,329, and that the changes, alterations, additions or improvements made to the ‘Brend’ machine by Defendant, American Pipe and Construction Co., are not such ‘improvements’ as are contemplated by paragraph (11) of the agreement of February 8, 1944.”

From this Finding of Fact and Conclusion of Law, the Appellee took no appeal to this Court. However, a controversy arose as to Finding of Fact 14, and its possible interpretation, and after a hearing in the Court below [R. 235], the Court on its own motion [R. 241] amended this Finding of Fact to read as follows [R. 64 and R. 241]:

“14.

“That Defendant, American Pipe and Construction Co., has not used in its operations any novel features brought to the art in any of Plaintiff’s three subsequent patents Nos. 2,639,942, 2,639,943 and 2,681,725; and is, therefore, not liable to Plaintiff for royalties for such use.”

The Court below, in its opinion [R. 60] stated:

“By the same token, the use of rubber brushes in this type of machine does not seem to be disclosed

in the prior art. And the Earnshaw patents 2639942, 2639943 and 2681725 have additional elements of originality. So we conclude that on the subject of invalidity, the defendant has not met the burden of proof and that the Earnshaw patents referred to are invention over the prior art.”

and Conclusion of Law 6 [R. 65] is as follows:

“That Defendant, American Pipe and Construction Co., failed to sustain the burden of proving Letters Patent Nos. 2,639,942, 2,639,943 and 2,681,725 to be invalid.”

It is because of Finding of Fact 14 and Conclusion of Law 6 that this appeal was taken by the Appellant on the ground that further litigation may probably ensue (Appellant’s Br. p. 11) and the Assignment of Errors in Appellant’s Brief, page 12, now designates claims 6, 7, 13 and 14 of Earnshaw Letters Patent No. 2,639,943 as the claims that the District Court should have found invalid. Invalidity of the other Earnshaw patents is not sought, but a finding by this Court is asked to the effect that the said patents, the three now in full force and effect, are not infringed by Appellant when used on the Brend machine equipped with rubber rollers in lieu of wire bristle brushes.

It is well to point out certain parts of the testimony given by Appellant’s witnesses in the Court below as well as testimony given by Mr. Earnshaw, the Appellee, with respect to the so-called wire brushes and rubber rollers. In Defendant’s Exhibit N [Exhibit Book, p. 297] admitted in evidence [R. 172] Mr. Earnshaw in his deposition states the characteristics of the Device of Patent No. 2,168,329 [Exhibit Book, p. 247, Ex. 2] to the ef-

fect that material was deposited on the belt and traveled along the belt and obtained velocity whereby [p. 302] the material is thrown by centrifugal action by the belt coming around the circle, and, further [p. 303], that:

“Then I took a piece of old, red innertube out of an automobile, and I sewed that together.

Q. In other words, you made rubber belts for those machines? A. I wouldn't say that the string and the clothesline was rubber.

Q. How about the red innertube? A. The red innertube was rubber, yes.

* * * * *

Q. Then it was within your range of knowledge at the time that you conceived the machine shown in that early patent of 1939 that you could use rubber belts, if you wished, in it? A. I was trying to find the very best kind of a belt there was. * * *

* * * * *

Q. [R. 304, Ex. M] And you knew at that time that rubberized or rubber-coated belts were common; isn't that a fact? A. Yes, there was rubber belts on the market.

Q. Now, you talked about this model that you have. Where is that model now? A. I have it. It's at my place.

Q. Is it in condition to demonstrate what you show in your early patent? A. Like I say, it's just a belt. I don't know whether the belt has deteriorated with age. I had a one-horsepower motor I was working with there on it. I don't know whether the deterioration of the belt would be so that we could drive it or not. We could see it, though, if you want to look at it.

Q. What material is the belt on that machine made of? A. I believe it's a four-ply rubber im-

pregnated canvas with about a sixteenth of an inch of rubber possibly on the surface of it.

Q. When did you make that model, approximately? A. I think it was in about '42."

This testimony is important for the reason that it shows that Earnshaw [as to Pltf. Ex. 2] actually contemplated the use of a rubber coated belt or belts for the handling of material which was to be thrown by centrifugal force from the belt or belts when it passed around the ejection end of a roller. In other words, the material would be driven tangentially from the belt when the belt was moved at a certain velocity.

Testimony concerning the use by Appellant of rubber rollers or latex impregnated bristle brushes was given by Appellant's witnesses Adolph G. Butler and Fred F. Jenkins, commencing at R. 134. Mr. Jenkins [R. 135] outlined the number of machines utilizing either rubber brushes or wire brushes at the several plants, amounting to six (6) machines with rubber rollers and three (3) with wire [R. 135], the Los Angeles plant having one (1) wire brush machine and two (2) rubber brush machines. He stated that eighty per cent (80%) of the pipe coating is now done with rubber rollers [R. 136] and that the substitution of rubber for wire was done late '47 or early '48 [R. 139]. The change was made on account of the war, the testimony being:

"A. On account of the war. During the war we were not able to purchase the type of wire brushes that we wished to buy. There is difference in the wire brushes. You have to have the right gauge of wire in the brushes in order to make them work satisfactorily, and it was hard to do. So we started in to try to protect the wire by using a rubber substance." [R. 139, 140.]

Mr. Butler [R. 142] testified, in part, as follows:

That the first wire brush for the coating of pipe was built in February of 1943 [R. 143] and that toward the end of 1947 was when American Pipe and Construction Co., at South Gate, commenced using rubber rollers [R. 144]. This was a coating process of the wires [R. 144], as follows:

“A. We were working with coating them at the time.

Q. What were you doing in connection with coating the wire brushes? A. How we were doing it?

Q. Yes. A. We were dipping them in a rubber solution, attempting to bond rubber to the individual wires.

Q. Why did you do that? A. We felt it might improve the life of the wire brush by doing that.

* * * * *

Q. In what respect? Longer wear? A. We are always looking for longer wear.

Q. That was the sole purpose, wasn't it? A. Anything that would prolong the life is desirable, yes.

* * * * *

Q. Now, you found that the rubber would outlast the wire brushes? A. At that time it didn't indicate the fact that we were improving them very much, no.

Q. Well, you continued to do that, though, to dip them or coat them, didn't you? A. We continued to try various methods of coating them.

Q. Yes. None of them worked very well, did they? A. None too well.

Q. The coating split, did it not? A. It had various factors that were—nothing resulted in a

very great improvement over what we already had.”
[R. 145.]

* * * * *

“Q. Then how long did that last? A. That lasted up until late in 1948, probably.

Q. Late 1948. Then you switched over to rubber then, did you, at that time? A. Gradually, back and forth.

Q. Well, when did you first start to use all rubber rollers or brushes? A. It was a matter of probably two or three years before we went exclusively, or went mostly, the greater percentage of it, to rubber.

Q. You mean two or three years after 1949, or when? A. After '48 or '47.

Q. 1948? A. Somewhere in there.

Q. When would that be,—1950 or '51? A. Probably it would be. When we decided it was probably desirable, and we thought we were doing a better job, or thought we have improved it some at that time.

Q. In other words, the rubber rollers you thought did a better job; is that right? A. We thought so, yes.” [R. 146.]

As to the advantages of rubber rollers over the wire brushes, Mr. Butler testified [R. 148], as follows:

“Q. Well, you re-groove the rubber rollers, don't you? A. Yes, we do.

Q. And you do that twice, don't you? A. We can do—occasionally we can do it twice. Not often.

Q. And you coat your big pipe, your big jobs with the rubber rollers, don't you? A. We do now, yes, sir.”

And, again [R. 149]:

“Q. Well, at first, when you started in on the the rubber, you didn’t have discs,—rubber rollers on discs, did you? A. No, we used the wire brush as a base.

Q. As a base. Now, in this local plant here, is it not a fact that the coating you are doing now is about 80 per cent with rubber rollers? A. That would be a good guess.”

The witness testified on R. 154 in answer to question:

“Q. Now, with the wire brushes, if a rock or a hard object goes through, it is apt to come out with great speed and is dangerous to the operators, is that not right? A. You say with the wire brushes?

Q. Yes. A. Yes, it is.

Q. That is not true with the rubber? A. No. It don’t come out.

Q. So that is safer? A. It is more costly, though. That’s right.”

The witness testified [R. 158, *et seq.*] that the life of rubber rollers in regular use last for 400 cubic yards of material, or 1,600,000 pounds [R. 159] and at R. 160, that the 400 cubic yards of material is the total life of the brush, and that they may be re-cut twice as a rule, and three times occasionally [R. 160], while the life of the wire brushes lasted 300 cubic yards [R. 160]. Mr. Butler also admitted that he had seen the two rubber tires mounted together in a garage at Mr. Earnshaw’s residence in 1948 [R. 166]. Further testimony was given by Mr. Butler [R. 167] concerning the dipping of

the wire brushes into a latex, and in answer to a question, stated:

“A. Well, I couldn’t bond them to the wire. I mean, I didn’t know the technique of bonding them to the wire.

* * * * *

A. Kirkhill finally helped us out on it, yes, sir.

* * * * *

A. That was in 1948, early.” [R. 167.]

Appellee has quoted from the testimony of Mr. Butler rather extensively for the reason that the Appellant has asserted in its Brief, page 23, that the use of the rubber rollers for wire bristled brushes assumedly as defined in Earnshaw Patent No. 2,639,943, and particularly claims 6, 7, 13 and 14, did not rise to the dignity of patentable invention. As to this, Appellee will respond in the Argument, and refer back to the testimony of Mr. Butler and Mr. Jenkins already given.

It is noteworthy that the Appellant introduced into evidence a book of exhibits, Exhibit AK [R. 213] of prior art alleged to anticipate the Earnshaw patents, Plaintiff’s Exhibits 5, 6 and 7. The Record shows that Appellant introduced the patents into evidence without explanation thereof, and no explanation of their applicability appears in the Appellant’s Opening Brief. The Appellee, however, produced Professor Robert L. Daugherty [R. 214], head of the Department of Mechanical Engineering, California Institute of Technology, to discuss the meaning of words and what to him the prior art patents introduced by Appellant disclosed. Professor

Daugherty first stated what the Appellee's patents, Exhibits 2, 5, 6 and 7, disclosed to him [R. 215, 216] followed by a discussion of the Brend patent, Defendant's Exhibit B, and gave a definition of "brush" [R. 217], to-wit:

"The Witness: That's right. It would mean a lot of separate bristles of some material."

and he identified Defendant's Exhibit I as a brush [R. 217], and Appellant's Exhibit J was not a "brush"—

"A. Because it doesn't have these separate flexible elements that are supported at one end, and with some supporting material." [R. 218.]

Thereafter, Professor Daugherty discussed each one of the patents, Exhibit AK, with a summary [R. 230] wherein he testified with reference to the patent devices:

"Q. (By Mr. Brown): —in your opinion, could they be utilized, the devices shown, in either the Brend device as disclosed in patent 2,380,499 in place of the bristles, or in the Earnshaw patent '943, Exhibit 5? A. You mean all these rotary pump devices?

Q. Yes. A. No, they could not be used in either one of these ways.

Q. And the reason. A. The reason is that they are not adapted to handle abrasive material, fundamentally. The next is they do not discharge the material with a high enough velocity. The purpose is entirely different. It is to deliver material from a low pressure zone to a high pressure zone.

Q. And you would say that the function is different, then? A. The function is completely different.

Q. And the results obtained different? A. Yes."

The witness gave several definitions of the words “resilient,” “elastic,” and in referring to the brush exhibit, testified [R. 229]:

“A. No, I don’t think it is a surface you could call resilient. The bristles of the brush can bend, but I would not think of that from an engineering standpoint as being a resilient surface.”

and the Court [R. 233], during cross-examination of the witness, asked:

“The Court: Resiliency, doesn’t that apply to going up and down rather than going side ways, the way a brush would?”

The Witness: That is the way I would take it.”

Professor Daugherty’s testimony with reference to the prior art patents was uncontradicted.

ARGUMENT.

1. Claims 6, 7, 13 and 14 of Letters Patent No. 2,639,943 and Letters Patents Nos. 2,639,942 and 2,681,725 Are Valid at Law.

The Appellee, in the Court below, produced the uncontradicted testimony of Professor Robert L. Daugherty to the effect that the prior art patents did not, in his opinion, anticipate the several Earnshaw patents. It is evident, therefore, that the Appellee is relying chiefly upon the deposition of Hugh Foster Kennison to establish an alleged prior public use of rubber rollers in a Brend machine of the type disclosed in the Brend brush patent, [Ex. D, Book of Exhibits, p. 279].

Appellant further asserts that claims 6, 7, 13 and 14 of Letters Patent No. 2,639,943 are invalid on the ground of lack of patentable invention.

In considering the testimony of Mr. Kennison, it is noted that Appellant relies on Title 35, United States Code, Section 102(a) and (g). Of course (g) also contains the words "In determining priority of invention there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to the conception of the other." This, of course, gives the patentee of the patent under attack the right to carry back his date of invention, if he is able to do so.

Mr. Kennison testified [R. 178, 179] that it was the early part of 1946 that brushes of rubber were tried and that rubber covered drums were actually built, as follows:

"A. Yes, they were actually built, and they were returned to us, and we ran—or produced some pipe with those brushes on June 13 and 14, of 1946." [R. 183.]

These rubber covered drums were run on a Brend type machine, as exhibited in the Brend patent, Exhibit 4, being substituted for the two wire brushes [R. 184].

"Q. And what was the reason why you were testing rubber-coated drums in lieu of wire brushes, if there is a reason. A. We were always looking for more economical means of producing pipes, and it was felt that rubber might have some advantage in this particular application." [R. 185.]

* * * * *

"Q. After you tested the rubber-coated brushes, as shown in Exhibit 5, '—which is R here—' as you have testified, what, if anything, did you do further in connection with rubber-coated brushes? A. Well, the tests indicated that the brushes would be—or

might be of advantage if we had greater allowance for depth of wear. These brushes we have just talked about only allowed for about $\frac{1}{2}$ " of radial wear. So later that year, we designed a new housing in which we could put in rubber vanes. This housing is illustrated on drawing B-1-567, dated 8-15-46." [R. 186.]

* * * * *

"Q. And I hand you what appears to be a photograph of purchase order 3236. What is that? A. This is the purchase order for that flat strip of rubber $\frac{1}{2}$ by 5, which we cut to special length and made the vanes similar to that illustrated on B-1-567." [R. 187.]

* * * * *

"A. This rubber was used, but it had a very poor fit in forming it into a U-shape.

Q. That is, into the socket which held it? A. Into the socket of the hub assembly. Pipe were made with this mechanism, but we found that due to centrifugal force, one leg of the extended U would extend and the other would come in, due to difference in weight of each of the arms of the U. As a result, this was redesigned. Drawing B-4-129, dated December 6, 1946, illustrates an extruded rubber shape for rubber vane coating brush. This was designed so that it could not be dislodged due to centrifugal force. And it was a pre-formed shape as opposed to our earlier attempt at rubber vanes." [R. 187-188.]

"Q. Was that actually built? A. This was actually built and used.

Q. And used on a Brend type of machine, of the type we have been discussing? A. Yes.

Q. And did it operate satisfactorily, except for

wear, if it did not operate satisfactorily for that purpose? A. It operated well enough to make several pipe. We did realize at that time, though, that again centrifugal force was stretching the rubber and we were getting some interference. At that time we discussed putting reinforced wire mesh in this extruded shape. But this was never actually tried." [R. 188.]

The dates given for the brushes of December of 1946 and tests conducted prior to March of 1947 [R. 188].

* * * * *

"Q. What was your ultimate conclusion, if you arrived at any, with respect to the use of rubber-coated drums of the types you have mentioned as compared with the wire brushes that you were using?

A. We felt that the cost of brush per cubic yard of mortar placed was more or less the same. At the same time, we were negotiating with several of the larger wire brush manufacturers for improved quality and price reduction, due to our quantity use of the brushes. This negotiation with the wire brush people was successful, *so we concluded our experiments* on the presumption we could get cheaper placement of mortar by using steel brushes, as well as that we felt the brush people could produce in the future cheaper and better brushes for this particular use." [R. 189, 190.] (Italics added.)

Again, on R. 191, the witness testified:

"Q. Now, ever since that time, that is, since 1946 or 1947 you have continuously used machines having brushes for this same function and purpose? A. Yes.

Q. And, as I understand it, you have about 15 of them with counter-rotating brushes in operation at this time. A. More or less.

Q. And they all use wire brushes, do they, or brushes of some other character? A. *They all use wire brushes.* In the past few years, we have had a few with steel vanes, using a similar principle to that shown on drawing—

Q. B-1-567? A. Yes, B-1-567.—excepting they are fixed steel fins, counter-rotating.” (*Italics added.*)

It is noteworthy to observe in the Kennison testimony that the first so-called experiment consisted of two drums which were covered with rubber by the Manhattan Rubber Company, and thereafter were grooved by a tire grooving machine at the plant of Lock Joint Pipe Company. This provided but two rubber covered drums to experiment with. Kennison immediately transferred the experiment from drums of this character to the use of rubber strips bent in U-form which he found did not function properly due to centrifugal force. It is obvious that the U-shaped form was one form of brush and thereafter Kennison concluded the experiments, as set forth in the Kennison testimony, R. 189, cited. It is quite evident that there was no public use of the devices and that Kennison's work was experimental, and an abandoned experiment. Nowhere in the testimony is there any statement by Kennison or by any one else connected with Lock Joint that the so-called experiments *were not* conducted in secret, that what was done was not suppressed, nor concealed. The testimony is silent. There is no indication that Manhattan Rubber Company knew anything about the use to which the rubber covered drums were to be put, other than that it was to cover two drums with rubber, and the testimony shows that Lock Joint, under Kennison's supervision, grooved the rubber, so Manhattan had nothing to do with this particular operation. It would seem that an infringer

should prove all the elements of the defense of prior public use, not only the actual use of the invention, but its public nature. (*Aerovox Corporation v. Polymet Mfg. Corporation*, 67 F. 2d 860, 861 (C. C. A., 2); *Whiteman v. Mathews*, 216 F. 2d 712 (C. C. A., 9).) It has been held by innumerable decisions that a subsequent invention is not anticipated where the earlier inventor conceals or suppresses the fact of his knowledge or use until the subsequent invention is made, as see:

Steinfur Patents Corp. v. Meyerson, 56 F. 2d 372.

An invention, the discovery and use of which is not made public but is concealed and kept secret, will not anticipate a patent for the same device thereafter discovered. (*Gayler v. Wilder*, 51 U. S. 477; *Kendall v. Winsor*, 62 U. S. 322, 328.) It is not felt that the Kennison testimony as to *experiments* made by him meets the requirements imposed on the Appellant of want of novelty of the claims of Patent No. 2,639,943. (*Rown v. Brake Testing Equipment Corp.*, 38 F. 2d 220, 223 (C. C. A., 9); *Radio Corp. v. Radio Engineering Lab.*, 293 U. S. 1, 7; *Contract Co. v. Hassam Paving Co.*, 227 Fed. 436, 440 (C. C. A., 9); *Selectasine Patents Co. v. Prest-O-Graph Co.*, 276 Fed. 260 (C. C. A., 9) and 282 Fed. 223 (C. C. A., 9); *Schumacher, et al. v. Buttonlath Mfg. Co.*, 292 Fed. 522, 531 (C. C. A., 9); *Carson Inv. Co. v. Anaconda Copper Mining Co.*, 26 F. 2d 651, 661 (C. C. A., 9).)

We should not forget that Kennison was the only witness of the so-called experiments, and it has been held

that the unsupported oral testimony of one witness is seldom strong enough to negative novelty of a patent beyond a reasonable doubt, as set forth by this Court in

Rown v. Brake Testing Equipment Corp., 38 F. 2d 220, 223 (C. C. A. 9),

“clear and satisfactory proofs, with reasonable doubts resolved against it.”

Also:

Paraffine Companies v. McEverlast, 84 F. 2d 335, 339 (C. C. A. 9).

The case of *Rem-Cru-Titanium v. Watson*, 152 Fed. Supp. 282 at 285, is of interest on the question of use of an invention under Title 35, United States Code, Section 102. In this case, the Court held, as follows:

“The word ‘known’ used in the statute means ‘publicly known.’ ”

citing the case of *Alexander Milburn Co. v. Davis-Bournonville Co.*, 270 U. S. 390, 46 S. Ct. 324, 70 L. Ed. 651, as well as others.

This is important because there is no testimony by Kennison, or anyone else, as to public knowledge of any one of the experiments by Kennison.

On the question of “experimental use,” the case of *Merrill v. Builders*, 197 F. 2d 16 (C. C. A. 10), is to the effect that an alleged prior use of an invention which was for the primary purpose of testing the device and was collateral to the development of the invention in its complete and perfected form, is not public use within the meaning of the patent statute.

The case of *Bourne v. Jones*, 114 Fed. Supp. 413, aff'd 207 F. 2d 173 (C. C. A. 5), is to the effect that the rule that an experimental use of an invention by or under the control of an inventor for the purpose of testing or improving his invention is not a public use within the meaning of the patent statutes does not extend to the experimental efforts of others not within his control.

The Appellant, however, in its brief, insists that it was incumbent upon the Appellee to show that he had the invention prior to the time of the so-called Kennison experiments to overcome the charge of public use. Such a rule is generally followed in Interference Practice between two rival inventors who have filed applications for patent in the Patent Office, and is commonly known as "carrying back the date of invention." Appellant states, in its brief, page 22:

"* * * and there is no evidence to the effect that Earnshaw conceived the idea of ridged rubber covered brushes prior to the filing date of his application for patent No. 2,639,943, * * *"

Appellee calls attention to the testimony of the Appellee as given in the Appellee's Deposition, Defendant's Exhibit M, Exhibit Book, page 297, identified, offered and received in evidence [R. 172] and which the Appellee refers to pursuant to Rule 26(f), Rules of Federal Procedure. This testimony is referred to and quoted in this brief on pages 6 and 7, wherein Mr. Earnshaw states that he made use of rubber covered belting in the machine shown in his Patent No. 2,168,329 [Ex. 2, Exhibit Book, p. 247]. This particular machine comprised upper and lower belts with means for feeding the plastic material onto the upper stretch of one of the belts and fed be-

tween the lower stretch of the other belt, with means for driving both belts, and for centrifugally throwing the plastic material from one of the belts as it passed around a roller, together with the means for directing the path of movement of the thrown plastic material.

Appellee does not understand the law to be that it is incumbent upon him to show any conception or reduction to practice date prior to an alleged public use or prior use date, in litigation of the character of this sort.

Patent No. 2,168,329 constitutes a constructive reduction to practice and the disclosure of this patent, together with the testimony of Mr. Earnshaw to the effect that he used rubber covered belting for gripping the plastic material and so used this type of belting on his model, places the date of concept and reduction to practice at least as early as the date of filing of the application for patent, to-wit: January 2, 1937.

Appellant's testimony as to dates of use of either rubber rollers or latex dipped wire brushes is such as to not affect the Earnshaw patent here under discussion. Mr. Butler of the American Pipe and Construction Co. testified as to the use of wire brushes in the Brend machine from 1943 to 1947 [R. 143]; latex dipped wire brushes in 1947 [R. 144] which, of course, do not constitute rubber rollers, with use by American of all rubber rollers in 1950 and 1951 [R. 146]. As stated, we do not see that Appellee has any issue to meet so far as concept and constructive reduction to practice or actual reduction is concerned, and Appellee has discussed the problem only because it was raised by the Appellant.

In this connection, it is interesting to note that the patent to Brend, Appellant's Exhibit B, Exhibit Book,

page 279, while disclosing and claiming wire brushes, sets forth this bit of interesting information on page 3 (second column), lines 17 to 23, inclusive:

“The impelling brushes may assume the form of a pair of high speed endless belts, preferably carrying bristles on their exteriors, and arranged to pass a locus forming a discharge throat between them in the manner and form of the throat 18 between the two rotary brushes shown in Fig. 2.”

Brend, of course, had no concept of the use of a rubber-covered roller or a rubber impregnated or covered belt, but Brend did contemplate a pair of high speed endless belts which, therefore, makes the Earnshaw patent, Plaintiff's Exhibit 2, Exhibit Book, page 245, all the more pertinent in the matters which we have been discussing hereinabove.

2. The Claims of Earnshaw Patent No. 2,639,943, Appellee's Exhibit 5, Book of Exhibits, page 257, Specifically Claims 6, 7, 13 and 14 Are Valid and Define Patentable Invention.

This Court has held in *Oriental Foods v. Chun*, 244 F. 2d 909; *Hall v. Wright*, 240 F. 2d 787; *Hutchens v. Faas*, 114 U. S. P. Q. 210; *Berkeley v. Jacuzzi*, 219 F. 2d 785, and *Bergman v. Aluminum*, 116 U. S. P. Q. 233, that novelty and invention are questions of fact, while validity is a question of law.

The Supreme Court of the United States has, in innumerable cases, stated factors that constitute evidence of invention, such as, for instance:

Doing a thing in a better or more facile way;
Reducing expense;
Simplifying the device or operation;

An element or elements for performing a new and different function;

Better results.

See:

Nye and Nissen v. Kasser, 96 F. 2d 420 (C. C. A. 9);
Loom Co. v. Higgins, 105 U. S. 580,

and a long list of cases following this decision as appears in Walker on Patents, Deller's Edition, Volume I, commencing page 147.

We have the testimony of both Mr. Earnshaw, the Appellee here, and the Appellant's witnesses, Mr. Butler and Mr. Jenkins, which has been quoted extensively from the record in this brief, at pages 7 to 11, to the advantages of the rubber rollers over wire brushes, to-wit, the use of rubber rollers was safer to the workmen [R. 154]; the life of the rubber rollers was longer because the rubber rollers could be recut at least two to three times and would, therefore, handle more yardage or more poundage of material [R. 158, 159]; that the rubber rollers would handle up to 400 cubic yards of material against 300 yards for the wire brushes [R. 159, 160]; and that wire brushes were more expensive than rubber rollers [R. 161]. All of these factors, testified to by the Appellant's own witnesses, Butler and Jenkins, evidences an invention within the cases referred to *supra*.

The District Court stated in its Opinion [R. 60]:

"By the same token, the use of rubber brushes in this type of machine does not seem to be disclosed in the prior art. And the Earnshaw patents 2639942, 2639943 and 2681725 have additional elements of originality. So we conclude that on the subject of

invalidity, the defendant has not met the burden of proof and that the Earnshaw patents referred to are invention over the prior art.”

Within the decisions of this Court enumerated *supra*, the District Court had the duty of finding on the questions of novelty and invention.

Conclusion.

We submit that the District Court was not required within the authorities to pass on the question of infringement by American, the Appellant here, of the Earnshaw patents; the District Court found the Earnshaw patents to be valid but not included within the terms of the License Agreement between the Appellant and Appellee. We submit that all of the Earnshaw patents, Nos. 2,639,942, 2,639,943 and 2,681,725 are valid.

Respectfully submitted,

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